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Appl. No. 10/632,724
Amdt. dated April 13, 2005
Reply to Office action of March 24, 2005

REMARKS/ARGUMENTS

Claim 1 has been cancelled without prejudice.

New claim 2, an independent claim, and dependent claim 3, both in Jepson form, make clear the improvement that the splice plate of the invention is capable of positioning the cross beams in the grid, in either a convex or a concave ceiling, so that the cross beams directly contact the curved drywall board. This was not taught in the prior art, but is clearly disclosed in the present application, in both the specification and the drawings.

The invention, as applied to a convex ceiling, is clearly shown in Figure 2 of the present application, and as applied to a concave ceiling, in Figure 7.

By attaching the dry wall board directly to the cross beams, a much stronger ceiling is produced. In the prior art, in a curved drywall ceiling, the cross beams in the grid had generally to be spaced away from the board, as shown in Figure 1, labeled "PRIOR ART", of the present application.

The Boegle '946 reference has no cross beams as now claimed, supported from a splice plate in a convex faceted curved ceiling, and no one would be led from Boegle to the presently claimed splice plate.

The remaining references are remote and do not teach the invention.

The present claimed invention, as now defined in new independent claim 2, and dependent claim 3, also is clearly patentable over the commonly owned reference, U.S. Patent 6,751,922, so that no terminal disclosure is necessary.

Claims 2 and 3 are now written in the form specifically approved by the Court of Custom and Patent appeals in *In re Venezia*, 530 F.2d 956, 189 USPQ 147 (CCPA 1976), copy attached as Appendix "A". This case is cited in the Manual of Patent Examining Procedure in Section 2173.05(g) Functional Limitations.

The invention claimed, in *Venezia*, included structural limitations on the claimed connector, which structural limitations were defined by how the connector is to be assembled with another identical connector in the final assembly, if assembled.

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The Venezia decision permits such claiming of a part, which is to be assembled with another part, in a group of two or more parts.

The Court stated:

"We see nothing wrong in defining the structures of the components of the completed connector assembly in terms of interrelationship of the components, or the attributes they must possess, in the completed assembly."

Underlining has been added.

This observation is remarkably pertinent to the present claims, which clearly define the invention in a form approved by Venezia. In the present claims, the splice plate is capable of positioning the cross beams next to the board in the assembled convex and concave ceilings.

As to obviousness, applicant respectfully draws the Examiner's attention to the Patent and Trademark Office Board of Appeal and Interference decision in Appeal No. 93-4004, dated June 29, 1994. A copy is attached as Appendix "A". This decision relates to a patent in the same art as

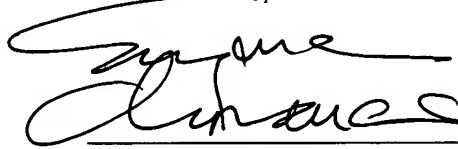
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the present application. It is believed that the law cited in the Board decision, which supports the argument of the present applicant as set forth above, should be controlling in the present situation.

Applicant believes the application is now in order for allowance, and respectfully requests such allowance.

13 April
2005

Respectfully submitted,



SIGNATURE OF PRACTITIONER

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applicable to interpreting 35 U.S.C. 101 "any manufacture;" Section 101 "same invention" type double patenting cases construe "a patent therefore."

5. Patentability — Subject matter for patent monopoly — In general (§51.601)

Group or "kit" of interrelated parts is 35 U.S.C. 101 "manufacture," and is not excluded from patent protection.

Particular patents — Splicing

Venezia, Method of Splicing High Voltage Shielded Cables and Splice Connector Therefor, rejection of claims 31-36 reversed.

Appeal from Patent and Trademark Office Board of Appeals.

Application for patent of J. William Venezia, Serial No. 31,500, filed Apr. 24, 1970. From decision rejecting claims 31-36, applicant appeals. Reversed.

Donald R. Dunner, and Lane, Aitken, Dunner & Ziems, both of Washington, D.C. (S. Michael Bender, North Tarrytown, N.Y., Richard A. Craig, New York, N.Y., and Arthur Jacob, Hackensack, N.J., of counsel) for appellant.

Joseph F. Nakamura (T.E. Lynch, of counsel) for Commissioner of Patents and Trademarks.

Before Markey, Chief Judge, and Rich, Baldwin, Lane, and Miller, Associate Judges.

Lane, Judge.

This is an appeal from the decision of the Patent and Trademark Office Board of Appeals (board) affirming the rejections of claims 31 through 36 in application serial No. 31,500, filed April 24, 1970, for "Method of Splicing High Voltage Shielded Cables and Splice Connector Therefor." We reverse.

The Invention

Appellant's invention is a splice connector having interrelated parts adapted to be assembled in the field to provide a splice connection between a pair of high voltage shielded electric cables.

Appellant's application contains claims drawn to the completed connector and to the method of making the splice connection, which have been allowed by the Patent and Trademark Office. On appeal before us are claims drawn to a splice connector "kit" consisting of the parts which are used in

making the splice in their unassembled condition.

Claim 31, with our emphasis, is representative of the claims on appeal:

31. A splice connector kit having component parts *capable of being assembled in the field at the terminus of high voltage shielded electrical cables* for providing a splice connection between first and second such cables, said cables each having a conductor surrounded by an insulating jacket within a conductive shield wherein a portion of the conductive shield is removed to expose the insulating jacket and a portion of the insulating jacket is removed to expose the conductor at the terminus of the cable, the kit comprising the combination of:

a pair of sleeves of elastomeric material, each sleeve of said pair *adapted to be fitted over the insulating jacket of one of said cables*, each said sleeve having an external surface and a resiliently dilatable internal bore for gripping the insulating jacket to increase the dielectric strength of the creep path along the insulating jacket;

electrical contact means *adapted to be affixed to the terminus of each exposed conductor* for joining the conductors and making an electrical connection therebetween;

a pair of retaining members *adapted to be positioned respectively between each of said sleeves fitted over the insulating jacket of each said cable and the corresponding terminus of each said cable*, said retaining members each having means cooperatively associated therewith for maintaining each said member's position relative to the insulating jacket on each said cable and for precluding axial movement of the sleeve toward the corresponding terminus of each said cable; and

a housing, said housing having an internal bore extending therethrough from end to end, said housing including portions adjacent each end thereof defining said internal bore and being resiliently dilatable *whereby said housing may be slideably positioned over one of said cables and then slideably repositioned over said sleeves*, said retaining members, and said contact means *when said sleeves, said retaining members and said contact means are assembled on said cables as hereinaforesaid*, said resiliently dilatable portions of said housing respectively gripping the corresponding external surface of each said sleeve in watertight sealing relationship therewith and said housing having a further portion intermediate its ends defining said internal bore and forming a sealed chamber

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enclosing at least said contact means and the exposed portions of said cable conductors *when said housing is in its repositioned location.*

The Rejections

Claims 31-36 were rejected under 35 USC 112, second paragraph, as indefinite and incomplete in not defining a completed article of manufacture. The examiner particularly relied on *In re Collier*, 55 CCPA 1280, 397 F.2d 1003, 158 USPQ 266 (1968), as support for this rejection.

Claims 31-36 were additionally rejected under 35 USC 101 because they were drawn to a plurality of separately and discretely listed and defined manufactures instead of a manufacture.

The Board

The board at first unanimously sustained both of the above rejections. With respect to the section 112 rejection it stated:

In the *Collier* case, the two elements [see bracketed elements [1] and [2] of *Collier* claim 17, *infra*] recited specifically in the claims there under consideration were described in terms of intended uses and capability, and the like. The Court said:

"We agree with the Board, however, that the claim does not positively recite structural relationships of the two elements, identified as (1) and (2) above, in its recitation of what may or may not occur. In this sense it fails to comply with section 112, [second paragraph] In [sic] failing distinctly to claim what appellant in his brief insists is his actual invention."

An inspection of the claims here under consideration, see for example claim 31 above, discloses a similar situation. Although the preamble refers to the structure as a "kit", the elements are recited without present cooperation. The language is futuristic and conditional in character, thus, a pair of sleeves - to be fitted - electrical contact means - to be affixed - a pair of retaining numbers [sic, members] - to be positioned - a housing - may be slideably positioned - slideably repositioned - when said sleeves are assembled on said cables - when said housing is in its repositioned location.

From the above it is clear that the language of the claim taken as an example is directed to assembly to take place in the future. No present positive structural relationships are recited.

In affirming the section 101 rejection the board stated:

[Appellant] urges that the elements of his claimed combination are "joined together in a kit of component parts". Such joining as may be recited in the claims, as we have pointed out above in connection with the rejection under 35 USC 112, relates to matters which may take place in the future. No *present* coaction is recited. The presence of the word "kit" in the preamble, we do not think fairly links the elements separately recited in the claims. Appellant has referred to no language in the claims which would support such "joining" and we know of none. [Emphasis in original.]

In a subsequent decision, upon reconsideration, one of the board members dissented, finding that appellant had distinctly claimed what he regarded as his invention under section 112. The dissenting member of the board also found that it was not fatal under section 101 that the cooperation of the claimed elements was recited as occurring at a future time.

This posture of the board remained intact following a third opinion rendered after a second request for reconsideration by appellant.

Opinion

Section 112 Rejection

[1] We have reviewed the disputed claims and in particular the language criticized by the examiner and the board. We conclude that the claims do define the metes and bounds of the claimed invention with a reasonable degree of precision and particularity, and that they are, therefore, definite as required by the second paragraph of section 112. In *re Conley*, 490 F.2d 972, 180 USPQ 454 (CCPA 1974); In *re Miller*, 58 CCPA 1182, 441 F.2d 689, 169 USPQ 597 (1971); In *re Borkowski*, 57 CCPA 946, 422 F.2d 904, 164 USPQ 642 (1970). As we view these claims, they precisely define a group or "kit" of interrelated parts. These interrelated parts may or may not be later assembled to form a completed connector. But what may or may not happen in the future is *not* a part of the claimed invention. The claimed invention does include present structural limitations on each part, which structural limitations are defined by how the parts are to be interconnected in the final assembly, if assembled. However, this is not to say that there is anything futuristic or conditional in the "kit" of parts itself. For example, paragraph two of claim 31 calls for "a pair of sleeves * * * each sleeve of said pair adapted to be fitted over the insulating jacket of one of said cables." Rather than being a mere direction

of activities to take place in the future, this language imparts a structural limitation to the sleeve. Each sleeve is so structured or dimensioned that it can be fitted over the insulating jacket of a cable. A similar situation exists with respect to the "adapted to be affixed" and "adapted to be positioned" limitations in the third and fourth paragraphs of the claim. The last paragraph of claim 31 contains additional language criticized by the board, including "may be slideably positioned," "slideably repositioned," "when said sleeves * * * are assembled," and "when said housing is in its repositioned location." However, this language also defines present structures or attributes of the part of the "kit" identified as the housing, which limits the structure of the housing to those configurations which allow for the completed connector assembly desired. Again, a present structural configuration of the housing is defined in accordance with how the housing interrelates with the other structures in the completed assembly. We see nothing wrong in defining the structures of the components of the completed connector assembly in terms of the interrelationship of the components, or the attributes they must possess, in the completed assembly. More particularly, we find nothing indefinite in these claims. One skilled in the art would have no difficulty determining whether or not a particular collection of components infringed the collection of interrelated components defined by these claims. In re Miller, supra.

[2] We also fail to see any basis for rejecting appellant's claims for being incomplete in failing to recite a completed assembly. Appellant's invention is a "kit" of parts which may or may not be made into a completed assembly. Since all of the essential parts of the "kit" are recited in the claims, there is no basis for holding the claims incomplete.

We cannot leave our discussion of the section 112 rejection without discussing In re Collier, supra, relied on by both the examiner and the board as support for this rejection. In Collier we were confronted by the following claim:

17. For use in a ground connection, [1] a connector member for engaging shield means of a coaxial cable means, said connector member comprising a substantially rectangular piece of metal formed into trough form to define a ferrule-forming member, said ferrule-forming member having

a series of perforations disposed therein toward the axis of the ferrule-forming member and defining inwardly

directed frusto-conical projections having jagged edges defining lances converging toward their tips.

said ferrule-forming member being crimpable onto said shield means with said lances keying into said shield means without penetrating insulation means disposed thereunder,

[2] and ground wire means for disposition between said ferrule-forming member and said shield means upon the ferrule-forming member being crimped onto the shield means,

said ground wire means being displaced in a series of bights around respective perforations to effect serpentine form when said ferrule-forming member is crimped onto said shield means. [55 CCPA at 1281-82, 397 F.2d at 1004-05, 158 USPQ at 267. (Emphasis and brackets in original opinion).]

In Collier appellant argued that we were to regard the italicized portions of claim 17 about intended uses, capabilities, and structures which would result upon the performance of future acts, as positive structural limitations. However, we found that the claim did not positively recite any structural relationship between the two elements identified as [1] and [2], in its recitation of what may or may not occur. We concluded that the claim failed to comply with section 112, second paragraph, in "failing distinctly to claim what appellant in his brief insists is his actual invention."

[3] There is no issue in this case of whether appellant is claiming what he regards as his invention. Moreover, although the claims before us contain some language which can be labeled "conditional," this language, rather than describing activities which may or may not occur, serves to precisely define present structural attributes of interrelated component parts of the "kit," such that a later assembly of the "kit" of parts may be effected. Thus, we find In re Collier inapposite to the claims presently before us.

Section 101 Rejection

35 USC 101 provides in pertinent part:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter * * * may obtain a patent therefor * * *.

Both the examiner and the board construed the language "any * * * manufacture" as excluding from its ambit claims drawn to a "kit" of parts, reasoning that a "kit" would be a plurality of separate manufactures, not a single manufacture.

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The solicitor in his brief recognizes that the Patent and Trademark Office has in the past issued patents containing similar claims drawn to "kits" of interrelated parts.¹ He argues, however, that double patenting decisions by this court, holding that an inventor may obtain only one patent on a single invention, show that this court has interpreted portions of section 101 in the singular. From this he reasons that the word "manufacture" in section 101 is to be similarly interpreted.

[4] We do not find our decisions on double patenting to be applicable to an interpretation of the words "any manufacture" in section 101. Suffice it to say that the two situations are totally dissimilar. In the section 101 "same invention" type double patenting cases, all we were construing was the phrase "a patent therefor."

No other authority has been cited, either by the board or the solicitor, to support the narrow construction which the Patent and Trademark Office now seeks to impose on the words "any manufacture" in section 101.

[5] We do not believe the words in question are to be so narrowly construed. To hold that the words "any manufacture" exclude from their meaning groups or "kits" of interrelated parts would have the practical effect of not only excluding from patent protection those "kit" inventions which are capable of being claimed as a final assembly (e.g., a splice connector), but also many inventions such as building blocks, construction sets, games, etc., which are incapable of being claimed as a final assembly. We do not believe Congress intended to exclude any invention from patent protection merely because it is a group or "kit" of interrelated parts. We therefore hold that a group or "kit" of interrelated parts is a "manufacture" as that term is used in section 101.

Accordingly, the decision of the board is reversed.

¹ There are copies of several patents in the record which contain "kit" claims exemplifying this prior practice, including patent No. 3,108,803, claiming a basketball goal set kit, patent No. 3,041,778, claiming a puppet kit, patent No. 1,974,838, claiming a toy construction set, and patent No. 3,355,837, also claiming a toy construction set.

Patent and Trademark Office Trademark Trial and Appeal Board

In re The Cyclone Seeder Co., Inc.

Decided Oct. 20, 1975

Released Dec. 19, 1975

TRADEMARKS

1. Identity and similarity — How determined — Dominant feature (§67.4065)

Identity and similarity — Words — Similar (§67.4117)

"Speedy" is determining element in "Cyclone Speedy Spreader," "Spreader" being disclaimed, with "Cyclone" modifying "Speedy" and suggesting enormous speed; "Cyclone Speedy Spreader" for broadcast spreader/seeders so resembles "Speedy" for corn cribs, power operated agricultural insecticide sprayers, corn shredders, and row crop shields that confusion is likely.

Appeal from Examiner of Trademarks.

Application for registration of trademark of The Cyclone Seeder Co., Inc., Serial No. 439,884. From decision refusing registration, applicant appeals. Affirmed.

Oltch & Knoblock, South Bend, Ind., for applicant.

Before Lefkowitz and Bogorad, Members, and Rice, Acting Member.

Bogorad, Member.

An application has been filed by The Cyclone Seeder Co., Inc. to register the mark "CYCLONE SPEEDY SPREADER", the word "SPREADER" being disclaimed, for broadcast spreader/seeders.

Registration has been refused under Section 2(d) of the Act of 1946 on the ground that applicant's mark as applied to the goods specified in its application so resembles the previously registered mark "SPEEDY" for corn cribs, power operated agricultural insecticide sprayers, corn shredders and row crop shields for use on cultivators' as to be likely to cause confusion or mistake or to deceive.

¹ Reg. No. 680,737 issued June 23, 1959, affidavit under Sec. 8 accepted, affidavit under Sec. 15 received.

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APPENDIX "B"

PAT.&T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONN, INC.¹

Appeal No. 93-4004
Reexamination 90/002,225²

HEARD:
June 3, 1994

Before STONER, LYDDANE, and MEISTER, Administrative Patent
Judges.

STONER, Administrative Patent Judge.

DECISION ON APPEAL

¹ Although the request for reexamination was filed in the name of USG Interiors, Inc. as the present owner of the patent under reexamination by virtue of assignment and merger, nevertheless, as indicated in Paper No. 3, the patent owner of record remains Donn, Inc.

² Request filed December 11, 1990, for the Reexamination of Patent No. 4,779,394, issued to Richard Shirey, Gerald L. Koski, Jonathan P. Teli and David F. Mieyal on October 25, 1988.

The patent owner appeals from the examiner's final rejection of claims 2, 3 and 6 through 26, in the final Office action mailed September 15, 1992. As the patent owner has pointed out at page 2 of the brief filed July 9, 1993,³ amendments after final rejection filed on December 23, 1992 and January 25, 1993, have been approved for entry.⁴ Claims 1, 4 and 5 have been canceled by the patent owner. We reverse.

The claimed invention relates to a suspension ceiling grid system. Like the examiner, we consider the summary contained in the brief (pages 2 through 7) correct and direct attention thereto. Claims 11 and 19 are illustrative of the subject matter on appeal and read as follows:

11. A suspension ceiling grid system comprising elongated grid runners interconnected at intersections including a through-runner and two opposed runner ends connected together on opposite sides of said through-runner, said runners including a web, an elongated vertically extending opening in the web of said through-runner having an upper end extremity and a lower end extremity, said through-runner web providing two remote sides, one of said two opposed runner ends being associated with one of said two remote sides, the other of said two opposed runner ends being associated with the other of said two remote sides.

³ All references to the brief in this decision are directed to the substitute brief filed July 9, 1993. The briefs filed February 9, 1993 and May 12, 1993, were ruled defective by the examiner.

⁴ We note that the former amendment has not yet been clerically entered, despite bearing the examiner's approval thereon.

generally planar end connectors on the ends of said opposed runners projecting into said opening [form] from opposite sides thereof, said connectors providing first lock means each operable to project through said opening and move lengthwise of said opening between a release position and a locked position in which said first lock means [engages the remote side of said web] provides a lateral projection extending beyond one end extremity of said opening along the associated remote side of said through-runner web for engagement therewith, each runner providing a flange along one edge of said web, said flange of each of said opposed runner ends engaging an adjacent side of said flange of said through-runner, said flange of said through-runner normally maintaining said lateral projection beyond said one end extremity of said opening along the associated remote side of said through-runner web, said flange of said through-runner being temporarily deflectable to permit passage of said projection through said through-runner opening, said connectors also providing connector-to-connector locking means directly interconnecting said connectors in a direction lengthwise of said opening and preventing relative longitudinal movement of said opposed runners in a direction away from each other.⁵

19. Elongated runners for suspension ceiling grid systems adapted to be interconnected at intersections including a through-runner and opposed runner ends connected to said through-runner on opposite sides thereof comprising through-runners providing a web having an elongated vertically extending opening therethrough having an upper end extremity and a lower end extremity, said web of said through-runner having two remote sides, one of said opposed runner ends being associated with one of said two remote sides, the other of said opposed runner ends being associated with the other of said two remote sides, opposed runners providing generally planar connectors at their ends adapted to extend through said opening, said connectors providing first lock means including [a projection along one edge thereof] an upper lateral projection along an upper edge thereof adapted to be positioned in alignment with the associated remote side of said through-runner web beyond [one] said upper end extremity of said opening, said first lock means also including a lower lateral projection along the lower edge of said connectors adapted to be positioned in alignment with the associated remote

⁵ Consistent with the specification, we understand the language of claim 2 regarding "said first-end-end-lock" to be a reference back to the "first lock means" recited in claim 11.

side of said through-runner web beyond the lower end extremity of said opening, said connectors also providing second lock means adapted to interconnect two connectors extending through said opening on both sides of said opening by relative movement between said connectors lengthwise of said opening.⁶

The references relied upon by the examiner are:

Brown et al. (Brown)	3,501,185	Mar. 17, 1970
Sauer	4,317,641	Mar. 2, 1982

Claims 2, 6 through 23, 25 and 26 stand rejected under 35 USC 103 as unpatentable over Brown, while claim 24 stands rejected under 35 USC 103 as unpatentable over Brown in view of Sauer. Rather than reiterate the examiner's statements of these rejections, we direct attention to pages 2 through 4 of the answer mailed August 11, 1993.

Having carefully considered the respective positions expressed in the examiner's answer and supplemental answer (mailed December 16, 1993), and in the patent owner's brief and reply brief, filed September 13, 1993, it is our determination that the examiner's rejections of these claims must be reversed. We find ourselves in agreement with the position expressed by the

⁶ Consistent with the specification, we understand the recitation in claim 6 of "said connector-to-connector lock" to be a reference back to the same structure termed a "second lock means adapted to interconnect two connectors" recited in claim 19.

patent owner that the suspension ceiling grid system of Brown is not one in which the flange of the through-runner is temporarily deflectable to permit passage of a projection on the connector through the through-runner opening as required by claim 11. Likewise, we see nothing in the teachings of Brown which would have suggested the oppositely extending lateral projections of claims 19 and 26. Nor is there anything in the teachings of Sauer, relied upon only in connection with claim 24, which would have made up for the deficiency of Brown.

The examiner's comments notwithstanding, we see nothing in Brown which remotely suggests any need for a temporary deflection of the flange of the through-runner during installation of the cross-runners. When the embodiment illustrated in Figures 8 through 13 is installed, a cross-runner is necessarily pivoted in a direction bringing the flange of the cross-runner from a position located remote from the flange of the through-runner down to a position in contact therewith, as is evident from the installed position illustrated in Figure 13. That is, as viewed in Figure 13, the cross-runner (at right) pivots clockwise into the full line position shown. There is no need for deflection of the flange of the through-runner. A similar analysis applies to the embodiment shown in Figures 1 through 7 of Brown. The end of the cross-runner illustrated in Figure 5 is notched to produce a

shoulder, as at 33, which stops short of the flange 16, providing clearance which permits installation of the cross-runner without any deflection of the flange of the through-runner. It follows that we do not share the examiner's view that, "temporary deflection may not be discernable in the experts's [sic] eyes, however, this deflection is an inherent feature of Brown's ceiling grid structure" (answer, page 5). Indeed, the Mieval affidavit as to the manner in which the connector of Brown's Figure 13 embodiment engages with the through-runner is consistent with our reading of the Brown disclosure.

The examiner is of the view that because the embodiment of Figures 1 through 7 provides a projection on the bottom, but not on the top, of the connector and because the embodiment of Figures 8 through 14 provides a projection on the top, but not on the bottom of that connector, it would have been obvious to one having ordinary skill in the art to provide the runner as shown in Figure 13 with a lower projection as taught for the Figure 1 embodiment. We see no basis for such a conclusion. Our court of review has repeatedly cautioned against applying hindsight by using the applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art. See, e.g., *Grain Processing corporation v. American Maize-products Co.*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir.

BOARD OF PATENT
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